

REMARKS

Claims 1-7 are pending. Claims 1-3, 6 and 7 stand rejected. Claims 4 and 5 are allowed according to the Office Action Summary sheet. The body of the Office Action states that claims 4 and 5 would be allowable if rewritten in independent form. Applicant respectfully refers to the Amendment of October 7, 2003, in which claims 4 and 5 were amended to be in independent form.

Applicant's Response to the Objection to the Specification

The Abstract has been objected to because the legal phraseology "disclosed" is used. Applicant respectfully submits that the Abstract which used the phraseology "disclosed" was substituted by the Abstract filed in the Amendment of October 23, 2003.

Applicant's Response to the Rejections Under 35 U.S.C. §102

Presently, claims 1-3, 6 and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ito et al. (USP 5,724,154).

The characterization of the rejection as falling under §102(b) due to Ito et al. being an anticipatory reference appears to be in error. The body of the rejection indicates that the Office Action has combined the Ito et al. reference with a new one, Sugaya. Hence, the rejection appears to be an obviousness rejection under §103, and Applicant responds to the rejection herein as a §103 rejection.

The rejection acknowledges that Ito et al. does not disclose the limitations of the detection of memory shortage, lowering resolution of images as a result thereof and

restarting the input data analysis as required by Applicant's claims. The Office Action has asserted that Sugaya discloses these limitations, and that one skilled in the art would combine the limitations of the claims as disclosed in Ito et al. with this Sugaya disclosure to derive the present invention.

Applicant respectfully traverses. Based on a review of Sugaya, Applicant respectfully submits that the reference does not sufficiently detail the limitations in such a way that one skilled in the art would be led to derive the current invention.

The Office Action specifically cites column 3, lines 6-14 as disclosing the memory shortage detection/resolution change/restart limitation. Sugaya discloses:

... when using a printer of the variable output resolution type that can change an output resolution, an input image is processed so as to facilitate the generation of a corresponding rasterized image.

Col. 3, lines 6-10. Applicant respectfully submits that this overall section of Sugaya is only describing related art and this particular section is noting memory problems therein. In essence, Sugaya's only disclosure is that printers are capable of making resolution changes from input data. Upon a review of Sugaya, there is no disclosure of the remaining elements of the claim; namely: (1) controller detects a memory shortage in the compressed area; (2) as a result of this detection, the controller lowers the resolution of drawing data; (3) the controller then repeats the input data analysis from the beginning of the print job.

Hence, Applicant respectfully submits that the rejection does not set forth a *prima*

facie showing of obviousness under §103 because the cited reference does not disclose all the material limitations of the claims, and the rejection does not address these limitations. The Federal Circuit Court has held that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In re Evanega, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1981)

In essence, a rejection under §103(a) cannot assume material limitations of the claims nor assume that deriving them would be within the skill of one in the art without any additional disclosure.

Wherefore, Applicant respectfully requests favorable reconsideration.


In the event that this paper is not timely filed, Applicant respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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